



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,228	03/29/2001	Takashi Tsue	2091-0236P-SP	2183
2292 7590 11/28/2007 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			EXAMINER BASHORE, WILLIAM L	
			ART UNIT 2176	PAPER NUMBER
			NOTIFICATION DATE 11/28/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

09/820,228

Applicant(s)

TSUE, TAKASHI

Examiner

William L. Bashore

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/22/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: amendment filed 9/5/2007, to the original application filed 3/29/2001. The instant application claims a foreign priority date of 3/29/2000.
2. Claims 1-48 pending. Claims 1, 6, 11, 13, 15, 17, 19, 21, 23, 26 are independent claims.

Claim Rejections - 35 USC § 103

3. **The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1, 5-6, 10-23, 26, 29-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayle et al. (hereinafter Mayle), U.S. Patent No. 6,542,936 issued April 2003, in view of Giannini et al. (hereinafter Giannini), U.S. Patent No. 7,062,454 issued June 2006.**

In regard to independent claim 1, Mayle teaches a method of creating an image display (i.e. a customized electronic postcard) (Mayle Abstract, column 2 lines 35-51). Mayle's customization process is a series of input screens associated with clickable tabs, said screens can be interpreted as a series (plurality) of templates, because each screen is specifically tailored to input and produce a piece of a final structured result (intermediate results are also displayed as a postcard is built) (Mayle column 8 lines 21-42, 60-67, Figures 6-17). In addition, a user can choose an image (i.e. a user image – "andrew2.gif") for insertion, accordingly (Mayle Figure 9-10). It is noted that no particular tab order is specified, therefore

Art Unit: 2176

when a photo is inserted (Figure 11 – after insertion, or at beginning), said photo is essentially inserted in all of the templates (including the final result) (compare with claim 1 “*A template displaying method comprising the steps of: reading a user image and a plurality of templates each having an image insertion area for inserting the user image therein;*”).

Mayle teaches embodiments comprising the display of a “Baby Journal” and a “Family Album”, which are forms of catalogs, typically comprising user images (Mayle column 13 lines 50 to column 14 lines 12).

Mayle does not specifically teach displaying the templates within said catalog along with user images, as well as inserting said user image within a template area. However, Giannini teaches a preview system comprising user submitted self image(s) inserted in a background template image(s), and displaying said template/user images as a form of catalog (Giannini Figure 16). It is noted that Giannini’s images are composite images comprising a user image(s) superimposed on a portion of various background images (i.e. beach, etc.), the various composite images concurrently displayed in catalog style accordingly. It is noted that although Giannini Figure 16 appears to show the same images, the intent is to showcase various products (i.e. sunglasses) under various backgrounds etc., therefore it is obvious to the skilled artisan that each composite image is essentially unique in some way (Giannini Figures 15, 16, column 13 lines 32-41, column 14 lines 8-25, column 18 lines 60-67, column 19 lines 1-17, 64-67, column 20 lines 1-30) (compare with claim 1 “*inserting the user image in the image insertion area of each of the templates and generating a catalog of the templates each having the user image therein*”, “*concurrently displaying a plurality of the templates of the catalog and the user image.*”, and “*wherein each template within the catalog has a unique layout of its respective image insertion area within the template.*”). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Giannini’s display of user images to Mayle, so that each of Mayle’s templates (with

Art Unit: 2176

background/user image(s)) can be displayed concurrently to a user for more concise inspection and customization, resulting in a more complete baby journal/family album.

In regard to dependent claim 5, Mayle teaches various images available for choosing (as explained above) (see Mayle Figure 10).

In regard to independent claim 6, claim 6 incorporates substantially similar subject matter as claimed in claim 1, and in further view of the following, is rejected along the same rationale.

Mayle teaches a plurality of user images available for use (Mayle Figure 10).

In regard to dependent claim 10, claim 10 incorporates substantially similar subject matter as claimed in claim 5, and is rejected along the same rationale.

In regard to independent claim 11, claim 11 reflects the apparatus comprising computer readable instructions used for performing the method as claimed in claim 1, and is rejected along the same rationale.

In regard to dependent claim 12, Mayle teaches a plurality of user images available for use (Mayle Figure 10).

In regard to independent claim 13, claim 13 reflects the apparatus comprising computer readable instructions used for performing the method as claimed in claim 1, and in further view of the following, is rejected along the same rationale.

Mayle teaches a plurality of user images available for use (Mayle Figure 10).

Art Unit: 2176

In regard to dependent claim 14, Mayle teaches a plurality of user images available for use (Mayle Figure 10). Mayle also teaches using a new template (Mayle Figure 17 items 1703a, 1703b).

In regard to independent claim 15, claim 15 reflects the computer readable medium comprising computer readable instructions used for performing the method as claimed in claim 1, and is rejected along the same rationale.

In regard to dependent claim 16, Mayle teaches a plurality of user images available for use (Mayle Figure 10).

In regard to independent claim 17, claim 17 reflects the apparatus comprising computer readable instructions used for performing the method as claimed in claim 1, and in further view of the following, is rejected along the same rationale.

Mayle teaches a plurality of user images available for use (Mayle Figure 10).

In regard to dependent claim 18, Mayle teaches a plurality of user images available for use (Mayle Figure 10). Mayle also teaches using a new template (Mayle Figure 17 items 1703a, 1703b).

In regard to claims 19-20, claims 19-20 reflect the apparatus comprising computer executable instructions for performing the methods as claimed in claims 6, 10 respectively, and in further view of the following, are rejected under the same rationale.

Mayle teaches its invention implemented using a server (Mayle column 2 lines 35-38).

Art Unit: 2176

In regard to claims 21-22, claims 21-22 reflect the apparatus comprising computer executable instructions for performing the methods as claimed in claims 6, 10 respectively, and in further view of the following, are rejected under the same rationale.

Mayle teaches its invention implemented using a server (Mayle column 2 lines 35-38).

In regard to independent claim 23, claim 23 incorporates substantially similar subject matter as claimed in claim 1, and is rejected along the same rationale.

In regard to independent claim 26, claim 26 incorporates substantially similar subject matter as claimed in claim 1, and is rejected along the same rationale.

5. **Claims 29-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayle and, Giannini, and further in view of Ho-Ka-Go! English Homepage (hereinafter Ho-Ka-Go), Nippon Telegraph and Telephone Corporation, pages 1-5, last updated 3/26/1998.**

In regard to dependent claim 29, and similarly dependent claims 31, 33, 35, 37, 39, 41, 43, 45, and 47, Mayle does not specifically teach a user image display area smaller than a display area for displaying the plurality of templates. However, Ho-Ka-Go teaches display areas of a plurality of templates and of a user image (Ho-Ka-Go page 3 item 5, and page 4 item 6, respectively). It is noted that the display area of the user image (item 6) is dimensionally smaller than the total display area of the four sample templates (item 5). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Ho-Ka-Go to Mayle, providing Mayle the benefit of efficient use of display space to aid in user selection.

Art Unit: 2176

In regard to dependent claim 30, and similarly dependent claims 32, 34, 36, 38, 40, 42, 44, 46, and 48, Mayle does not specifically teach a user image larger than an image insertion area. However, Giannini teaches an oblong template corresponding to the shape of a person's head. Since this template size can be superimposed onto a background image, said oblong template reflects the size of the insertion area within said background image. A user image head can then be reduced to fit said template (implying that the user image is originally larger than the insertion area (Giannini column 17 lines 43-48, column 18 lines 5-10). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Giannini to Mayle, providing Mayle the benefit of scaling a person's image to fit various backgrounds accordingly.

6. **Claims 2-4, 7-9, 24-25, 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayle and Giannini, as applied to independent claims 1 and 6 above, and further in view of Manolis et al. (hereinafter Manolis), U.S. Patent No. 6,583,799 issued June 2003.**

In regard to dependent claims 2, 3, 4, Mayle does not specifically teach lower resolution images and templates. However, Manolis teaches thumbnail generation (lower resolution) in association with a catalog display (Manolis column 7 lines 4-25). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Manolis's low resolution method to Mayle's and Ho-Ka-Go's images and template images, providing Mayle the benefit of thumbnail representations for a more complete catalog picture.

In regard to dependent claims 7, 8, 9, claims 7, 8, 9 incorporate substantially similar subject matter as claimed in claims 2, 3, 4, and are rejected along the same rationale.

In regard to claims 24-25, claims 24-25 incorporate substantially similar subject matter as claimed in claims 2-4, and are rejected along the same rationale.

In regard to claims 27-28, claims 27-28 incorporate substantially similar subject matter as claimed in claims 2-4, and are rejected along the same rationale.

Response to Arguments

7. Applicant's arguments filed 9/5/2007 have been fully and carefully considered but they are not persuasive.

Applicant argues that Mayle does not teach “generating a catalog of the templates each having the user image therein”. The examiner respectfully disagrees. Giannini teaches a preview system comprising user submitted self image(s) inserted in a background template image(s), and displaying said template/user images as a form of catalog. Giannini’s teaching is applied to Mayle accordingly. Mayle can be reasonably interpreted as a plurality of templates because each screen is specifically tailored to input and produce a piece of a final structured result (intermediate results are also displayed as a postcard is built).

Upon further examination, it has been determined that reference Ho-Ka-Go is not needed in some of the instant rejections. Giannini teaches at Figure 16 four composite template images. Although it may appear that said images are the same, the point of Figure 16 is to show “favorite” images of users “virtually” trying on various products, therefore the intention is to showcase different products on users with the possibility of showing different backgrounds, etc.

The Ho-Ka-Go reference is still retained to show at least differing resolutions, etc.

Art Unit: 2176

Regarding Applicant's arguments on pages 4-5 of the amendment. It is respectfully noted that Giannini teaches inserting a plurality of "different" images (i.e. different sunglasses) onto an image, with possible differing backgrounds etc. (see Giannini at least Figure 16).

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas Duong whose telephone number is (571) 272-4088. The examiner can normally be reached on 9:00 am - 5:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached on (571) 272-4137. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



**WILLIAM BASHORE
PRIMARY EXAMINER**

November 21, 2007